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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,225	05/02/2001	David S. Gress	95-460	7396
23164	7590	03/07/2006	EXAMINER	
LEON R TURKEVICH 2000 M STREET NW 7TH FLOOR WASHINGTON, DC 200363307			RAMOS FELICIANO, ELISEO	
			ART UNIT	PAPER NUMBER
			2687	

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/846,225

Applicant(s)

GRESS ET AL.

Examiner

Eliseo Ramos-Feliciano

Art Unit

2687

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

ADVISORY ACTION

Response to Arguments

1. Applicant's arguments filed January 30, 2006 have been fully considered but they are not persuasive.
2. Applicant argues six (6) points in the response filed January 30, 2006 (pages 1-15). Each one of these is separately addressed as follows. Arguments previously discussed and properly explained as summarized by Applicant are not repeated herein but are incorporated by reference from pertinent previous Office actions.
3. **Point #1** (starting on page 2): Applicant argues "regardless of message type preferences" as part of the claims. Applicant, therefore, concludes that the applied prior art does not teach detecting the text-to-speech messaging command within the SMS message.

In response, the argument "regardless of message type preferences" is a reference to every possible message type preference. Some preferences available in the knowledge generally available to one of ordinary skill in the art are conditional reception of messages and no reception of messages. Consequently, Applicant's allegation is not supported by the original disclosure nor recited in the claims. In addition, to one of ordinary skill in the art it is not clear if Applicant had possession of every possible message type preference at the time the application was filed as argued.

Independent from above argument, detecting the text-to-speech messaging command within the SMS message is met by the combination of the applied prior art references. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. As indicated in previous Office action Luther (USPN 5,640,590)

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in combination with Schwelb et al. (USPN 5,950,123) and Jones (USPN 5,832,221) meet argued limitations (see column 4, lines 24-30 and Figure 3B of Luther).

4. **Points #2 (2a, 2b)** (starting on page 5): Applicant argues there is no motivation to combine applied prior art references.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine Jones can be found in column 8, lines 51-55 of Jones. The motivation to combine Luther can be found in column 4, lines 24-30 of Luther. In addition, the motivation or suggestion to combine the references can be found in the knowledge generally available to one of ordinary skill in the art. See *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004).

The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

5. **Point #3** (starting on page 9): Applicant argues that Luther is not analogous art.

In response to applicant's argument that Luther is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be

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reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Luther concerns translation of a text message via text-to-speech technology. This is the same field of applicant's endeavor and is pertinent to the particular problem with which the applicant is concerned.

6. **Point #4** (starting on page 11): Applicant argues the motivation provided by Luther.

In response, Luther teaches that it is preferable for the text-to-speech command parameters to be embedded in the text fed to a text-to-speech converter, so as to avoid the possibility of desynchronization between the speech commands and the text with which those commands are associated (column 4, lines 24-30 of Luther). Therefore, it is the same Luther who teaches that it is desirable to include text-to-speech commands within the "short" text message to avoid the possibility of desynchronization between the speech commands and the text with which those commands are associated. The rejections are based on combinations of references, not Luther nor Schwelb et al. alone.

7. **Point #5** (starting on page 12): Applicant argues an intended purpose.

In response to applicant's argument, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Luther's motivation is clear: it is desirable to include text-to-speech commands within the "short" text message to avoid the possibility of desynchronization between the speech commands and the text with which those commands are associated (column 4, lines 24-30 of Luther).


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The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

8. **Point #6** (starting on page 13): Applicant argues Luther does not teach text-to-speech messaging command causing invoking.

In response to applicant's arguments against Luther individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The combination of Schwelb et al., Jones and Luther meets the argued limitation as explained in previous Office action. For clarification, Schwelb et al. teaches converting text-to-speech (see e.g. abstract of Schwelb et al.); therefore, invoking conversion. Luther teaches such conversion is based on text-to-speech commands embedded in the text (see column 4, lines 24-30 of Luther).


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PRIMARY EXAMINER

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February 28, 2006